REMARKS

Status of the Application

Claim 42 is pending. Claim 42 stands rejected under 35 U.S.C. § 112 and 35 U.S.C. § 102.

Claims 1 and 41 were canceled in a previous action, which cancellation is herein affirmed. Claim 42 is amended to reinstate the composition of Formula I(a), the elected subspecies, and to delete the compositions of Formulae I(e) through I(p) which represent non-elected subspecies. Claim 42 was also previously amended to correct Markush language used therein, and is further amended herein to delete the Markush language since a single subspecies is represented by the given formula, Formula I(a). The claim is also amended to specify that the composition is a "charge transfer" composition. This amendment is supported in the disclosure at page 1, lines 33-34; page 2, lines 31-37; page 5, lines 28-29; Example 1; and Table 1. Finally, the claim is amended to delete references to Formulae I(e) through I(p). No new matter has been introduced.

Claim Rejection – 35 U.S.C. § 112

Applicants submit that the foregoing amendments render this rejection moot, and accordingly, request that it be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claim 42 is rejected under 35 U.S.C. § 102(b) as being anticipated by either Kuder et al., *J. Org. Chem.* 44, No. 5, 761-766 or U.S. Patent No. 6,004,709 to Renfer et al. Appicants respectfully submit that the foregoing amendment overcomes this rejection. Kuder discloses triphenylmethanes listed in Figure 1 at Col. 1, page 762 where a generic structure is given with different R_1, R_2, R_3, X and Z substituents. The lower portion of the Figure immediately below the table gives the structures of compounds examined in the study (XI, XII, XIII, XIV and XV). The utility given for triarylmethane dyes is as dyes in the textile and printing industry and as indicators in analytical chemistry (Col. 1, page 761, first full paragraph). The study presented in the paper focuses on anodic oxidation of compounds in dye formation. Renfer discloses a bis-(2-methyl-4-diethylaminophenyl)-phenylmethane as a stabilizer for an overcoating solution (Col. 2, lines 25-59). In Renfer, overcoats are applied to the charge transfer member of an electrophotographic imaging member and representative charge transfer structures are shown at Col. 19, lines 35-48. Renfer also states that the charge transport layer should be substantially free (i.e., < ~ 2%) of triphenylmethane (Col. 20, lines 9-12).

The disclosure and claim 42, as amended, are directed to a charge transport composition having Formula I(a). This limitation is neither disclosed nor suggested in either independently cited reference. Rather, Kuder discloses that the compositions presented in Figure 1 of that reference are useful as synthetic dyes in the textile or printing industries, or as precursors of such dyes, and as indicator solutions in analytical chemistry. Renfer discloses as the sole utility for the triarylamines recited therein that the compounds may be used as stabilizer additives for the charge transport layer overcoat (which is separate from, and chemically bonded to, the charge transfer layer). Neither disclose nor suggest that triarylamines may be charge transport (e.g., hole transport) compositions and accordingly, this limitation is lacking from both references. To anticipate an invention, a single reference must disclose each and every limitation of the claim or claims under examination. More specifically, for any claim under review to be anticipated under §102(b) by a prior art patent or publication, each element (or limitation) of each claim under review must be identically shown in a single reference. These elements must also be arranged as in the claim under review. *In re Bond*, 15 USPQ2d 1566, 1567 (CAFC 1990). In addition, and importantly, for a prior art reference to anticipate a claimed invention, the reference must enable a person of ordinary skill in the art to produce the claimed invention from a single reference cited against the invention to defeat novelty. *Elan Pharms. Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 68 USPQ2d 1373 (CAFC 2003)(in particular, 68 USPQ2d at 1375-76, "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled" in other words, the reference must enable that which it is cited as anticipating). See generally *In re Donohue*, 226 USPQ 619 (CAFC 1985). In summary, the claim element "charge transport" composition is absent from both references, and neither reference enables the charge transport in, for example, an OLED, by use of a triphenylamine as a charge transport carrier. Therefore, two critical elements of a prima facie case of anticipation are missing with respect to claim 42, as amended.

Applicants recognize, as they must, that compound I in Kuder (Figure 1, page 676) and bis-(2-methyl-4-diethylaminophenyl)-phenylmethane shown in Renfer at Col. 20, lines 50-60, disclose the compound of Formula I(a) recited in claim 42. However, Kuder discloses no utility for this compound, other than to say that triarylamines generally have been useful as dyes in the textile and printing industries or as indicators in chemical analysis. Renfer discloses the compound as a stabilizer additive to an overcoating composition, and claims it as such (claim 4, "An electrophotographic imaging member according to claim 3 wherein the

stabilizer is bis-(2-methyl-4-diethylaminophenyl)-phenylmethane.") A finding that prior art references disclosing a use distinct and different from that claimed is not anticipatory is proper and consistent with some leading case law. In *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.2d 989, 54 USPQ2d 1227 (CAFC 2000) Atlantic Richfield (Arco) sought to invalidate Union Oil Co.'s (Unocal) patent (5,288,393) on grounds of anticipation and lack of written description. (Page references are to 54 USPQ2d.) The claims of Unocal's patent were directed to automotive fuels with reduced CO, NOx and HC tailpipe emissions. Arco argued essentially that its racing and aviation fuels anticipated Unocal's automotive fuels. The CAFC, in upholding the trial court's judgment and verdict in favor of Unocal stated that, "Specifically, this alleged prior art does not include the limitation of being a standard automotive fuel composition" (p. 1232, col. 1, first full paragraph) and "while the record shows that some properties of the aviation and racing fuels coincide with the properties of the '393 patent's claims, the record does not show the presence of each and every limitation" (p. 1232, col. 1, second paragraph). A critical limitation in this case was that Unocal's fuels were claimed as automotive fuels (fuels for the mass consumption market). In our case, Kuder discloses the compound as a comparative to those (XI – XV) that may be effectively oxidized, while the Renfer reference claims, as shown above, the compound as an additional element of an electrophotographic imaging member, namely, a stabilizer additive for the overcoating composition.

Applicants respectfully assert that claim 42, as amended, sets forth a patentably distinct utility and application for the recited compound and that thereby by the anticipatory references cited against claim 42, as amended, have been overcome.

Conclusion

Applicants respectfully submit that a thorough and responsive reply to the Office Action of June 12, 2006 has been made in this paper and that the anticipating references of Kuder and Renfer have been overcome by the amendments made herein. A notice allowance for claim 42 is earnestly solicited.

Respectfully submitted,

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